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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,326	07/25/2003	Rolf Mintgen	5253-25	2283

27799 7590 10/19/2004

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EXAMINER

SICONOLFI, ROBERT

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

10/627,326

**Applicant(s)**

MINTGEN ET AL.

**Examiner**

Robert A. Siconolfi

**Art Unit**

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

1. Applicant response to the previous restriction requirement resulted in a invalid election. Applicant stated "Figures 25-33 all depict slide valves (claim 8), which are mutually exclusive of the features of Figure 1, which depicts a seat type valve (claim 7). The requirement to elect one of the subspecies AA-II therefore creates a conflict with Applicants' desire to elect the valve seat arrangement shown in Figure 1." This statement is incorrect. Figures 29-33 **do not depict slide valves but seat valves** as applicant admits in paragraph 90 in the Specification.

2. Applicants further state "Turning now to the embodiments disclosed in the application, Figures 2-15 illustrate various arrangements which could be used in conjunction with the feature shown in Figure 1." This is also contrary to what is present in the specification. Figures 2-15 are all referred to as separate embodiments in paragraphs 29-42 of the Specification. Secondly, It is clear that the valve arrangements presented in figures 2-10 could not be used together with the valve arrangement of figure 1 and therefore are independent. Similarly, figures 11-15 represent replacements for the piston of figure 1. Furthermore, in paragraph 75 of the Specification, "Figures 2 to 15 illustrate the wide variety of arrangements of ... lines, ... nonreturn valves, ... the volume-equalizing chamber 20 , the function of these parts corresponding to the function in Figure 1." Therefore, it is clear that the arrangements presented in figures 2-15 are replacements for the arrangement in Figure 1 and therefore, could not be used together.

***Election/Restrictions***

3. This application contains claims directed to the following patentably distinct species of the claimed invention:

Pick one of the following damper setups:

Species A	Figure 1
Species B	Figures 2 and 3
Species C	Figure 4
Species D	Figure 5
Species E	Figure 6
Species F	Figure 7
Species G	Figure 8
Species H	Figure 9
Species I	Figure 10
Species J	Figure 11
Species K	Figure 12
Species L	Figure 13
Species M	Figure 14
Species N	Figure 15

Pick one of the following seals:

Subspecies A	Figures 16 and 17
Subspecies B	Figure 18
Subspecies C	Figures 19-21

Subspecies D

Figures 22-24

Pick one of the following valves, If Species A is elected, applicant **must select** from Subspecies EE-II:

Subspecies AA

Figure 25

Subspecies BB

Figure 26

Subspecies CC

Figure 27

Subspecies DD

Figure 28

Subspecies EE

Figure 29

Subspecies FF

Figure 30

Subspecies GG

Figure 31

Subspecies HH

Figure 32

Subspecies II

Figure 33

Applicant must pick one from each category.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

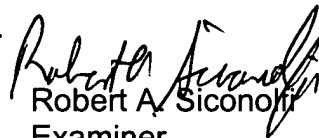
Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Siconolfi whose telephone number is 703-305-0580. The examiner can normally be reached on M-F 10 am-3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on (703) 308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 10/11/04  
Robert A. Siconolfi  
Examiner  
Art Unit 3683

RS